

**REMARKS**

Claims 1-9, 11-14 and 16-22 are pending. Claims 10 and 15 have been canceled. Claims 5-6 have been withdrawn. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

**Claims 21 and 22 Are Allowable if Rewritten in Independent Form**

The applicants appreciate that the examiner has withdrawn the sole rejection applied to claims 21 and 22. Accordingly, claims 21 and 22 are allowable if rewritten in independent form.

**Rejected Claims**

Claims 1, 2, 8 and 9 were rejected under 35 USC 103(a) as being obvious over U.S. Patent No. 5,384,174, Ward et al. ("Ward") in view of U.S. Patent No. 5,212,002, Madrzak et al. ("Madrzak"). Claims 3, 4, 13, 14 and 17-20 were rejected under 35 USC 103(a) as being unpatentable over Ward in view of Madrzak, further in view of U.S. Patent No. 5,008,110, Benecke et al. ("Benecke"). Claims 7, 11, 12 and 16 were rejected under 35 USC 103(a) as being unpatentable over Ward, Madrzak, and Benecke, further in view of U.S. Patent No. 5,376,418, Rogers et al. ("Rogers"). The applicants respectfully request that these rejections be withdrawn for reasons including the following, which are provided by way of example.

Independent claim 1, for example, recites that "the protective material is provided as first and second portions thereof, *only* on first and second sides of the second surface of the base material, wherein *the first and second sides do not touch one another*, the first and second portions being *spaced apart*." In Ward, in comparison, the second piece (14) (protective material) forms a circle, so that Ward's first and second sides touch.

Claim 1 also recites "the first and second portions defining a void therebetween." In Ward, to the contrary, the central area (13) surrounded by second piece (14) is removed when the adhesive sheet is used (col. 6, lines 51-53). Ward's adhesive sheet has an entirely different purpose from the present sheet which is intended to be wound on a roll so that the void between the first and second portions acts as a spacer. Ward's sheet would not be wound into a roll, and if it was, the central area (13) inside the second piece (14) prevents the spacer effect, and the second piece (14) which curves around especially defeats the spacer effect.

Applicants further note that there has been no proper reason to combine. Citing from MPEP 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with *no change in their respective functions*, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396. *If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*

It is respectfully submitted that the Office Action is defective for failing to comply with *KSR*, as enunciated in MPEP 2143. The proposed combination would change the respective functions of the elements in the cited art.

The applicants respectfully submit that no proper motivation has been shown for the combination of art cited in the rejection, at least because:

(1) the contended combination of teachings to reach the claimed invention would render the cited art inoperable for their respective purposes;

(2) the contended combination of teachings to reach the claimed invention would change the principles of operation of the devices shown in the respective cited art; and

(3) no reason has been shown that, as of the date of the instant application, would have prompted one skilled in the art to make the combination to reach the claimed invention.

Specifically, Ward discloses an adhesive sheet material for use on the skin and describes ostomy flanges and IV dressings (e.g., Abstract).

Madrzak discloses a splice on the leader of a paper roll utilized in running webs of paper (col. 1, lines 6-7).

Ward's adhesive ostomy sheets/IV dressings are not used to connect webs such as paper rolls, or even to each other. Since there is no joint between ostomy sheets/IV dressings, there is no reason to "keep the thickness at the joint area low". Under *KSR*, the proposed combination requires a change in function of at least Ward, and the proposed combination would yield not only unpredictable results but moreover undesirable results. Since one of the required findings cannot be made, the examiner's rationale cannot be used to support a conclusion of obviousness under *KSR*.

Furthermore, Ward's device and Madrzak's device are in different fields, and are not similar devices. Ward is in the field of skin wound dressings. Madrzak is in the field of splices for running webs of paper. Ward lacks any suggest of running the ostomy sheets/IV dressings as a running web or winding the ostomy sheets/IV dressings into rolls.

Finally, in Ward and Madrzak, there is no demand for surface smoothness desired by the present invention.

In view of the disparity of problems addressed by the applied references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from the applicants' own disclosure. It is respectfully submitted therefore that the independent claims are patentable over Ward alone or in combination with the other references of record.

Claim 3 is also believed to be distinguished from Ward and/or Madrzak, alone or in combination with the other references, for similar reasons.

With respect to the rejected dependent claims, the applicants respectfully submit that these claims are allowable not only by virtue of their dependency from independent claims 1 and 3, but also because of additional features they recite in combination.

### **Conclusion**

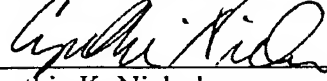
The applicants respectfully submit that, as described above, the cited art does not show or suggest the combination of features recited in the claims. The applicants do not concede that the cited art shows any of the elements recited in the claims. However, the applicants have provided specific examples of elements in the claims that are clearly not present in the cited art.

The applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples the applicants have described herein in connection with distinguishing over the cited art as limiting to those specific features in isolation. Rather, for the sake of simplicity, the applicants have provided examples of why the claims described above are distinguishable over the cited references.

In view of the foregoing, the applicants submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,

  
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